

REMARKS

I. Status Of Application

Claims 1-58 were pending in the application; the status of the claims is as follows:

Claim 41 has been cancelled;

Claims 17-38 have been withdrawn from consideration;

Claims 39 and 58 are rejected under the first paragraph of 35 U.S.C. § 112;

Claims 1, 2, 6, 9, 10, 13, 39-42, 46, 49-51, 54 and 58 are rejected under 35 U.S.C. § 102(b) over each of U.S. Patent No. 4,377,609 to Bartoli et al. (hereinafter "Bartoli") and U.S. Patent No. 3,795,722 to Sassaman (hereinafter "Sassaman");

Claims 3, 8, 15, 16, 43, 48, 56, and 57 are rejected under 35 U.S.C. § 103(a) over each of Bartoli and Sassaman in view of applicant's acknowledged prior art;

Claims 4, 5, 7, 11, 12, 14, 44, 45, 47, 52, 53, and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

II. Drawings

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicant respectfully requests receipt of this document when it becomes available.

III. Claim Objections

The objection to claims 4, 5, 7, 11, 12, 14, 44, 45, 47, 52, 53, and 55 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is noted. However, the independent claims from which these claims depend are considered to be in condition for allowance. Accordingly, rewriting these claims in independent form would involve unnecessary expense and effort. Therefore, it is respectfully requested that the objection to claims 4, 5, 7, 11, 12, 14, 44, 45, 47, 52, 53, and 55 be reconsidered and withdrawn.

IV. 35 U.S.C. § 112 Rejection

The rejection of claims 39 and 58 under the first paragraph of 35 U.S.C. § 112, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention, is respectfully traversed based on the following.

Claim 39 depends from claim 1, and claim 58 depends from claim 40. Claims 39 and 58 each recite *inter alia* “wherein said fixed portion is substantially rigid.” Antecedent basis for “said fixed portion” is provided in claims 1 and 40, respectively, which each recite *inter alia* “a panel...further having a fixed portion.” It is disclosed in the specification, as filed, that “the panels...are typically made of solid cardboard having a thickness of about 2 mm (0.08 in) but can be made of other materials and have other thicknesses.”¹

As the basis for the present § 112 rejection, the present Office Action alleges that “[t]here is no original disclosure directed to said fixed portion being substantially rigid....Clearly cardboard 2 mm thick is not normally considered substantially rigid.” However, this allegation is respectfully traversed. It is first respectfully pointed out that the term “cardboard” is a relatively generic term that embodies many types of paper board. For example, well-known binder board is defined as “a cardboard used by bookbinders to make covers for books.”² Despite the reference to books in the definition, binder board has been used in other applications such as boxes and slipcases.³ One type of binder board is “Davey Board”, which is a type of binder board originally made by the Davey Company, and which is described as being “good enough to withstand severe stresses” at

¹ Specification as filed, page 8, lines 26-28.

² <http://www.dictionary.com/search?q=binder%20board> (citing WordNet ® 1.6, © 1997 Princeton University) (printed August 26, 2002) (See Exhibit A included herewith).

³ Acid-Free Binders (Davey) Board, <http://www.reuels.com/reuels/product4561.html> (printed August 26, 2002) (See Exhibit B included herewith).

thicknesses including those ranging from 1.7 mm to 2.5 mm.⁴ Thus, it is well known to have a rigid piece of cardboard that is about 2 mm thick.

Further, it should be pointed out that the specification does not limit the panel to a piece of cardboard that is about 2 mm thick, but also states that the panel “can be made of other materials and have other thicknesses.”

Therefore, one skilled in the art would appreciate that, given the disclosure that “the panels...are typically made of solid cardboard having a thickness of about 2 mm (0.08 in) but can be made of other materials and have other thicknesses,” the inventor had possession of a substantially rigid fixed portion as recited in claims 39 and 58.

It should also be noted that binder (Davey) board is but one type of known rigid cardboard, cited here merely as an example, and not intended to limit any of the claims.

Accordingly, it is respectfully requested that the rejection of claims 39 and 58 under the second paragraph of 35 U.S.C. § 112 be reconsidered and withdrawn.

V. 35 U.S.C. § 102(b) Rejection

A. § 102(b) over Bartoli

The rejection of claims 1, 2, 6, 9, 10, 13, 39, 40, 42, 46, 49-51, 54 and 58 under 35 U.S.C. § 102(b) over Bartoli is respectfully traversed based on the following.

1. *Claims 1, 2, 6, 9, 10, 13, and 39*

Claims 2, 6, 9, 10, 13, and 39 depend from claim 1. Accordingly, the following discussion of claim 1 applies equally to claims 2, 6, 9, 10, 13, and 39.

⁴ Conservation paper/boards Acid Free Davey Board, <http://www.preservationequipment.com/137.html> (printed August 26, 2002) (See Exhibit C included herewith).

By this Amendment, claim 1 has been amended to include further structural definition related to the first hinge. As a result, claim 1, as amended, recites *inter alia*:

a panel having a front surface, a back surface, and a plurality of edges extending from said front surface to said back surface, said panel further having a fixed portion, a first hinge and a first flap, said first flap being divided from said fixed portion by said first hinge, said first flap being continuously pivotable about said first hinge between a first relaxed position and a first biased position, **said first hinge being defined by a path of greater flexibility relative to portions of the panel not included in said path so as to provide a predetermined hinging position;**

(Emphasis added). Thus, the first hinge defines a structural feature of the pad since the panel must be provided with “a path of greater flexibility relative to portions of the panel not included in said path.”

Bartoli is not concerned with producing or providing a pad with a hingable panel. Rather, Bartoli relates to producing a foam pad with a fabric cover on all sides. Bartoli is silent with regard to any portion of the pad including “a path of greater flexibility relative to portions of the panel not included in said path.” Therefore, since Bartoli fails to disclose or suggest all of the limitations of claim 1, Bartoli cannot anticipate or render obvious claim 1, or claims 2, 6, 9, 10, 13, and 39 which depend from claim 1.

2. *Claims 40, 42, 46, 49-51, 54, and 58*

Claims 42, 46, 49-51, 54, and 58 depend from claim 40. Accordingly, the following discussion of claim 40 applies equally to claims 42, 46, 49-51, 54, and 58.

By this Amendment, claim 40 has been amended to include further structural definition related to the first hinge. As a result, claim 40, as amended, recites *inter alia*:

a panel having a front surface, a back surface, and a plurality of edges extending from said front surface to said back surface, said panel further having a fixed portion, a first hinge and a first flap, said first flap being divided from said fixed portion along said first hinge, said first flap being continuously pivotable about said first hinge between a first relaxed

position and a first biased position, **said first hinge being defined by a path of greater flexibility relative to portions of the panel not included in said path so as to provide a predetermined hinging position;**

(Emphasis added). Thus, the first hinge defines a structural feature of the pad since the panel must be provided with “a path of greater flexibility relative to portions of the panel not included in said path.”

Bartoli is not concerned with producing or providing a pad with a hingable panel. Rather, Bartoli relates to producing a foam pad with a fabric cover on all sides. Bartoli is silent with regard to any portion of the pad including “a path of greater flexibility relative to portions of the panel not included in said path.” Therefore, since Bartoli fails to disclose or suggest all of the limitations of claim 40, Bartoli cannot anticipate or render obvious claim 40, or claims 42, 46, 49-51, 54, and 58 which depend from claim 40.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 6, 9, 10, 13, 39-42, 46, 49-51, 54 and 58 under 35 U.S.C. § 102(b) over Bartoli be reconsidered and withdrawn.

B. § 102(b) over Sassaman

The rejection of claims 1, 2, 6, 9, 10, 13, 39-42, 46, 49-51, 54 and 58 under 35 U.S.C. § 102(b) over Sassaman is respectfully traversed based on the following.

1. *Claims 1, 2, 6, 9, 10, 13, and 39*

Claims 2, 6, 9, 10, 13, and 39 depend from claim 1. Accordingly, the following discussion of claim 1 applies equally to claims 2, 6, 9, 10, 13, and 39.

As pointed out above, claim 1, as amended, includes a first hinge provided with “a path of greater flexibility relative to portions of the panel not included in said path.”

Sassaman is not concerned with producing or providing a pad with a hingable panel. Rather, Sassaman relates to producing a foam pad with a “skin” (e.g. homogeneous polyurethane) cover on all sides. Sassaman is silent with regard to any portion of the pad including “a path of greater flexibility relative to portions of the panel not included in said path.” Therefore, since Sassaman fails to disclose or suggest all of the limitations of claim 1, Sassaman cannot anticipate or render obvious claim 1, or claims 2, 6, 9, 10, 13, and 39 which depend from claim 1.

2. *Claims 40, 42, 46, 49-51, 54, and 58*

Claims 42, 46, 49-51, 54, and 58 depend from claim 40. Accordingly, the following discussion of claim 40 applies equally to claims 42, 46, 49-51, 54, and 58.

As pointed out above, claim 40, as amended, includes a first hinge provided with “a path of greater flexibility relative to portions of the panel not included in said path.”

Sassaman is not concerned with producing or providing a pad with a hingable panel. Rather, Sassaman relates to producing a foam pad with a “skin” (e.g. homogeneous polyurethane) cover on all sides. Sassaman is silent with regard to any portion of the pad including “a path of greater flexibility relative to portions of the panel not included in said path.” Therefore, since Sassaman fails to disclose or suggest all of the limitations of claim 40, Sassaman cannot anticipate or render obvious claim 40, or claims 42, 46, 49-51, 54, and 58 which depend from claim 40.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 6, 9, 10, 13, 39-42, 46, 49-51, 54 and 58 under 35 U.S.C. § 102(b) over Sassaman be reconsidered and withdrawn.

VI. 35 U.S.C. § 103(a) Rejection

A. § 103(a) over Bartoli in view of Acknowledged Prior Art

The rejection of claims 3, 8, 15, 16, 43, 48, 56, and 57 under 35 U.S.C. § 103(a) over Bartoli in view of Applicant's acknowledged prior art is respectfully traversed based on the following.

I. *Claims 3, 8, 15, and 16*

Claims 3, 8, 15, and 16 depend from claim 1.

As discussed above, claim 1, as amended, includes a panel must be provided with "a path of greater flexibility relative to portions of the panel not included in said path." However, Bartoli fails to disclose or suggest a panel having "a path of greater flexibility relative to portions of the panel not included in said path." Therefore, while it is acknowledged that the present rejection is based on a combination of Bartoli and Applicant's admitted prior art, it is noted that, since Bartoli fails to disclose or suggest all of the limitations of claim 1, Bartoli cannot render obvious claim 1, or claims 3, 8, 15, and 16 which depend from claim 1. As will be discussed next, Applicant's admitted prior art fails to provide for the deficiencies of Bartoli with respect to the present rejection.

Applicant's admitted prior art is relied upon in the present rejection for teaching the use of a fastener to attach an article to a substrate. However, even if Applicant's admitted prior art were to provide such teaching, Applicant's admitted prior art is silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path."

Thus, both Bartoli and Applicant's admitted prior art are silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path." As a result, even if one skilled in the art were to combine the teachings of Bartoli with Applicant's admitted prior art, the resulting combination would still be silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path."

Therefore, since the combination of Bartoli and Applicant's admitted prior art fails to disclose or suggest all of the limitations of claim 1, the combination of Bartoli and Applicant's admitted prior art cannot render obvious claim 1, or claims 3, 8, 15, and 16 which depend from claim 1.

2. *Claims 43, 48, 56, and 57*

Claims 43, 48, 56, and 57 depend from claim 40.

As discussed above, claim 40, as amended, includes a panel must be provided with "a path of greater flexibility relative to portions of the panel not included in said path." However, Bartoli fails to disclose or suggest a panel having "a path of greater flexibility relative to portions of the panel not included in said path." Therefore, while it is acknowledged that the present rejection is based on a combination of Bartoli and Applicant's admitted prior art, it is noted that, since Bartoli fails to disclose or suggest all of the limitations of claim 40, Bartoli cannot render obvious claim 40, or claims 43, 48, 56, and 57 which depend from claim 40. As will be discussed next, Applicant's admitted prior art fails to provide for the deficiencies of Bartoli with respect to the present rejection.

Applicant's admitted prior art is relied upon in the present rejection for teaching the use of a fastener to attach an article to a substrate. However, even if Applicant's admitted prior art were to provide such teaching, Applicant's admitted prior art is silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path."

Thus, both Bartoli and Applicant's admitted prior art are silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path." As a result, even if one skilled in the art were to combine the teachings of Bartoli with Applicant's admitted prior art, the resulting combination would still be silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path."

Therefore, since the combination of Bartoli and Applicant's admitted prior art fails to disclose or suggest all of the limitations of claim 40, the combination of Bartoli and

Applicant's admitted prior art cannot render obvious claim 40, or claims 43, 48, 56, and 57 which depend from claim 40.

Further with regard to claim 57, since claim 57 depends from allowable claim 55, claim 57 is further considered to be allowable for the reason of depending from an allowable claim.

Accordingly, it is respectfully requested that the rejection of claims 3, 8, 15, 16, 43, 48, 56, and 57 under 35 U.S.C. § 103(a) Bartoli in view of Applicant's acknowledged prior art be reconsidered and withdrawn.

B. § 103(a) over Sassaman in view of Acknowledged Prior Art

The rejection of claims 3, 8, 15, 16, 43, 48, 56, and 57 under 35 U.S.C. § 103(a) as being unpatentable over Sassaman in view of Applicant's acknowledged prior art is respectfully traversed based on the following.

I. *Claims 3, 8, 15, and 16*

Claims 3, 8, 15, and 16 depend from claim 1.

As discussed above, claim 1, as amended, includes a panel must be provided with "a path of greater flexibility relative to portions of the panel not included in said path." However, Sassaman fails to disclose or suggest a panel having "a path of greater flexibility relative to portions of the panel not included in said path." Therefore, while it is acknowledged that the present rejection is based on a combination of Sassaman and Applicant's admitted prior art, it is noted that, since Sassaman fails to disclose or suggest all of the limitations of claim 1, Sassaman cannot render obvious claim 1, or claims 3, 8, 15, and 16 which depend from claim 1. As will be discussed next, Applicant's admitted prior art fails to provide for the deficiencies of Sassaman with respect to the present rejection.

Applicant's admitted prior art is relied upon in the present rejection for teaching the use of a fastener to attach an article to a substrate. However, even if Applicant's

admitted prior art were to provide such teaching, Applicant's admitted prior art is silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path."

Thus, both Sassaman and Applicant's admitted prior art are silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path." As a result, even if one skilled in the art were to combine the teachings of Sassaman with Applicant's admitted prior art, the resulting combination would still be silent with regard to a panel having "a path of greater flexibility relative to portions of the panel not included in said path."

Therefore, since the combination of Sassaman and Applicant's admitted prior art fails to disclose or suggest all of the limitations of claim 1, the combination of Sassaman and Applicant's admitted prior art cannot render obvious claim 1, or claims 3, 8, 15, and 16 which depend from claim 1.

2. *Claims 43, 48, 56, and 57*

Claims 43, 48, 56, and 57 depend from claim 40.

As discussed above, claim 40, as amended, includes a panel must be provided with "a path of greater flexibility relative to portions of the panel not included in said path." However, Sassaman fails to disclose or suggest a panel having "a path of greater flexibility relative to portions of the panel not included in said path." Therefore, while it is acknowledged that the present rejection is based on a combination of Sassaman and Applicant's admitted prior art, it is noted that, since Sassaman fails to disclose or suggest all of the limitations of claim 40, Sassaman cannot render obvious claim 40, or claims 43, 48, 56, and 57 which depend from claim 40. As will be discussed next, Applicant's admitted prior art fails to provide for the deficiencies of Sassaman with respect to the present rejection.

Applicant's admitted prior art is relied upon in the present rejection for teaching the use of a fastener to attach an article to a substrate. However, even if Applicant's admitted prior art were to provide such teaching, Applicant's admitted prior art is silent

with regard to a panel having “a path of greater flexibility relative to portions of the panel not included in said path.”

Thus, both Sassaman and Applicant’s admitted prior art are silent with regard to a panel having “a path of greater flexibility relative to portions of the panel not included in said path.” As a result, even if one skilled in the art were to combine the teachings of Sassaman with Applicant’s admitted prior art, the resulting combination would still be silent with regard to a panel having “a path of greater flexibility relative to portions of the panel not included in said path.”

Therefore, since the combination of Sassaman and Applicant’s admitted prior art fails to disclose or suggest all of the limitations of claim 40, the combination of Sassaman and Applicant’s admitted prior art cannot render obvious claim 40, or claims 43, 48, 56, and 57 which depend from claim 40.

Accordingly, it is respectfully requested that the rejection of claims 3, 8, 15, 16, 43, 48, 56, and 57 under 35 U.S.C. § 103(a) over Sassaman in view of Applicant’s acknowledged prior art be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

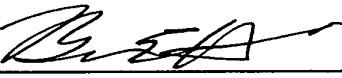
This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP’s Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be

construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 

Brian E. Harris
Registration No. 48,383
Agent for Applicant

BEH:bar

SIDLEY AUSTIN BROWN & WOOD LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3461
Main: (214) 981-3300
Facsimile: (214) 981-3400
August 28, 2002



APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

The following is a marked-up version of the changes to the claims which are being made in the attached response to the Office Action dated May 29, 2002.

IN THE CLAIMS:

1. (Three Times Amended) An upholstery pad, comprising:

a panel having a front surface, a back surface, and a plurality of edges extending from said front surface to said back surface, said panel further having a fixed portion, a first hinge and a first flap, said first flap being divided from said fixed portion by said first hinge, said first flap being continuously pivotable about said first hinge between a first relaxed position and a first biased position, said first hinge being defined by a path of greater flexibility relative to portions of the panel not included in said path so as to provide a predetermined hinging position;

a padding member having a front surface and a back surface, at least a portion of said back surface of said padding member being adhesively attached to said front surface of said panel, wherein said padding member extends across said first hinge; and

a sheet having a front surface and a back surface, at least a portion of said back surface of said sheet being adhesively attached to said front surface of said padding member;

wherein pivoting said first flap about said first hinge away from said first relaxed position and toward said first biased position causes a first force to be produced which urges said first flap to be pivoted about said first hinge toward said first relaxed position.

40. (Twice Amended) An upholstery pad for mounting on a substructure, comprising:

a panel having a front surface, a back surface, and a plurality of edges extending from said front surface to said back surface, said panel further having a fixed portion, a first hinge and a first flap, said first flap being divided from said fixed portion along said

first hinge, said first flap being continuously pivotable about said first hinge between a first relaxed position and a first biased position; position, said first hinge being defined by a path of greater flexibility relative to portions of the panel not included in said path so as to provide a predetermined hinging position;

a padding member having a front surface and a back surface, at least a portion of said back surface of said padding member being adhesively attached to said front surface of said panel, wherein said padding member extends across said first hinge; and

a sheet having a front surface and a back surface, at least a portion of said back surface of said sheet being adhesively attached to said front surface of said padding member;

wherein pivoting said first flap about said first hinge away from said first relaxed position and toward said first biased position causes a first force to be produced which urges said first flap to be pivoted about said first hinge toward said first relaxed position and wherein said first flap is positioned in said first biased position when said upholstery pad is positioned in said substructure such that said upholstery pad is maintained in position in said substructure by a frictional force between said upholstery pad and said substructure by said first force.

41. Cancelled.